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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/640,822 08/17/00 GERS-BARLAG H BEI 637- KGB

EXAMINER

HM12/1004

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WELLS, L	
ART UNIT	PAPER NUMBER

1619
DATE MAILED: 9
10/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/640,822	Applicant(s) GERS-BARIAG ET AL.	
Examiner Lauren Q Wells	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 September 2001.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

DETAILED ACTION

Claims 1-15 are currently pending. Claims 12-15 were added per the Amendment received September 14, 2001, Paper No. 7.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed September 14, 2001 (Paper No. 7) to the rejection of claim 1-11 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive. The Applicant's arguments to the rejection of claims 1-2, 4 and 6-10 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive. Therefore, the said rejection is hereby withdrawn.

103 Rejection Maintained

The rejection of claims 1-11 and newly added claims 12-15 under 35 U.S.C. 103(a) as being unpatentable over Msika et al. (5,939,054) in view of Nakane et al. (5,182,103) is MAINTAINED for the reasons set forth in the Office Action mailed March 3, 2001, Paper No. 4, and those found below.

Applicant argues "what is the examiner's standard that the Msika et al. reference "met" the claims recited by the applicants". This argument is not persuasive, as the reference teaches water-in-oil emulsions comprising the same constituents as the composition of the instant invention. Applicant further argues "if Msika et al. truly "met" the applicants claims Msika et al. would be a 102(b) references for claims 1-7 and 9-11". This argument is not persuasive. Msika et al. teach all the claim limitations of the instant composition, but fail to exemplify the composition, hence the 103 rejection.

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Applicant argues that the Msika et al. reference teaches away from the instant invention and further argues that the compositions of Msika et al. can not be used as prior art because “their invention is directed toward sunscreen composition which contains not only a specific amount of titanium oxide and zinc oxide particles but a synergic amount. . .”. and that “applicants claims may or may not have titanium oxide/zinc oxide whereas in Msika et al. this is a primary feature of their invention.” This argument is not persuasive. First, the Examiner respectfully points out that both Msika et al. and the instant invention are directed toward cosmetic compositions and furthermore that they both contain sunscreen agents. Second, the Examiner respectfully points out that the instant invention uses open language for the transitional phrase. See MPEP 2111.03. The transitional term “comprising” . . . is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 305 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (B. App. 1948)(“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). In regard to Applicant’s argument that “there would be no motivation by one of ordinary skill in the art to remove this feature from Msika et al”, the Examiner again respectfully refers Applicant to MPEP 2111.03 and also respectfully points out a reference is not limited to its working examples, but must be evaluated for what it teaches those of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966).

Applicant argues that “the fatty and/or waxy components of the applicants claims must have a melting point of above 40 C which is not taught or suggested by the Msika et al.

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reference". This argument is not persuasive. Msika et al. teach glycerol monolaurate, liquid paraffin, beeswax, ether of myristyl, carnauba wax and others as fatty and/or waxy components, and that the instant invention recites these same fatty and/or waxy components on pages 17-18 and 39-44 of the specification for use in the composition.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
September 21, 2001



**DAMERON L. JONES
PRIMARY EXAMINER**